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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,899	11/29/2000	Olga Bandman	PF-0187-2 DIV	3562
27904	7590	02/23/2004	EXAMINER	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304				ROARK, JESSICA H
		ART UNIT		PAPER NUMBER
		1644		

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/726,899	BANDMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jessica H. Roark	1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED **FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.** Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of the final rejection.  
**ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION.** See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on 31 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.  The proposed amendment(s) will not be entered because:

- (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  they raise the issue of new matter (see Note below);
- (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3.  Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

*PHILLIP GAMBLE*  
 PHILLIP GAMBLE, PH.D  
 PRIMARY EXAMINER  
*707 CONN 1600*  
*2/19/04*

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 3 and 6.

Claim(s) rejected: 1,2,4,5 and 7-11.

Claim(s) withdrawn from consideration: 12 and 13.

8.  The drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_

Continuation of 3. Applicant's reply has overcome the following rejection(s):

- a) Applicant's amendment has obviated the previous rejection of claims 1-2 and 9-11 under 35 U.S.C. 112 first paragraph (enablement and written description).
- b) Applicant's evidence that there are multiple polypeptides of the same size as SEQ ID NO:3 establishes that the antibody of Bentlage et al. does not necessarily bind the polypeptide of SEQ ID NO:3. Accordingly, the previous rejection of claims 1 and 4 under 35 U.S.C. 102(b) as being anticipated by Bentlage et al. (Biochimica Biophysica Acta 1995; 1234:63-73, of record) is withdrawn.
- c) After further review, it is noted that claims 3 and 6 each require screening steps using the polypeptide of SEQ ID NO:3. Because SEQ ID NO:3 is not taught by the prior art, the previous rejection of claims 3 and 6 under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (J. Mol. Bio. 1992;226:1051-1072, IDS #2), in view of Bentlage et al. (Biochimica Biophysica Acta 1995; 1234:63-73, of record), and in further view of Ramakrishnan et al. (US Pat No. 5,817,310, of record), is withdrawn.

Continuation of 5. does NOT place the application in condition for allowance because:

- a) The amendment to claim 1 does not affect the rejection of record of claims 1-2, 4-5 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (J. Mol. Bio. 1992;226:1051-1072, IDS #2), in view of Bentlage et al. (Biochimica Biophysica Acta 1995; 1234:63-73, of record), and in further view of Ramakrishnan et al. (US Pat No. 5,817,310, of record). Accordingly, the rejection of claims 1-2, 4-5 and 7-11 is maintained for the reasons of record.
- b) Claims 3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



Docket No.: PF-0187-2 RCE

Response Under 37 C.F.R. 1.116 - Expedited Procedure  
Examining Group 1653

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 23, 2003.

By:  Printed: Jeannie G. Labra

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Bandman et al.

Title: **ANTIBODIES TO SUBUNITS OF NADH DEHYDROGENASE**

Serial No.: **09/726,899** Filing Date: **November 29, 2000**

Examiner: **Roark, J.** Group Art Unit: **1644**

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Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT AFTER FINAL**

Sir:

Please amend the application as follows:

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09/726,899